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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,362	11/15/2001	Hisashi Kugimoto	CU-2720 RJS	4660
26530	7590	03/22/2004	EXAMINER	
LADAS & PARRY 224 SOUTH MICHIGAN AVENUE, SUITE 1200 CHICAGO, IL 60604			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/003,362

Applicant(s)

KUGIMOTO, HISASHI

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

This Office Action is responsive to the amendment filed 6-4-03. The Examiner acknowledges the RCE and cancellation of claim 3.

### ***Claim Objections***

1. Claims 1, 6, and 7 are objected to because of the following informalities: "an adhesive being separable together with said protection film" is not grammatically correct. Appropriate correction is required. Additionally, claim 6 includes the limitation "through the protection film is 82% or more," which appears to also be grammatically incorrect. Instant claim 7 includes the limitation, "the protection film is pasted from the side of the adhesive," which does not make sense.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "said resin film" in line 4. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, the Examiner will assume the base sheet is the resin film.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

6. Claims 1-2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,870,224 to Saitoh et al.

Saitoh teaches a lenticular sheet (1210, equivalent to Applicant's base sheet of a lens) comprising a UV curable resin on its surface, on the side of a transparent resin film support that has the lens part on it. The resin film has a protective film (8, equivalent to applicant's protective film) on each side of the film and an adhesive agent (1110, equivalent to applicant's adhesive) adhered to the film (see col. 4, lines 15-55, Figure 12, and col. 5, lines 43-64).

Regarding claim 2, the adhesive strength of 0.4 to 2.3 N/25mm is inherent since the same material is used.

Regarding claim 4, the adhesive agent contains a polyolefin-based resin component, polyethylene terephthalate at col. 4, line 53.

Regarding claim 6, a support film (base sheet) is taught at col. 5, lines 15-20 having a UV curable resin on it and at col. 4, lines 46-54, the support is of PET or PVC. Further at col. 5, line 50, adhesive 1110 is taught as having a protective film 8 on it. Both 1110 and 8 are on the

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support film 1210. It is known that supports are molded as the same process in Applicant's disclosure at col. 1, line 64-col. 2, line 4. At col. 5, lines 47-50, Saitoh explains that both film 7 and protective film 8 are peeled away leaving the adhesive 1110 on the lenticular sheet 1210. Such explanation is equivalent to Applicant's limitation "adhesive being separable together with said protection film from base sheet".

That a transmittance of UV rays transmit through the protection film is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. The product of the Applicant and prior art is the same.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0924537 to Aoyama et al. in view of USPN 5,870,224 to Saitoh et al.

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Aoyama teaches an antireflection article for attachment to an optical display such as a liquid crystal display screen. See [0002]-[005]. The substrate (base sheet) is of an acrylic resin (equivalent to a UV-curable resin film layer), see [0043]), as per instant claim 5. A fluoropolymer coating is over the substrate. Antistatic agents and cationic surfactants (equivalent to cationic surface active agent) are employed to the acrylic resin layers and/or the fluoropolymer resin layer to prevent accumulation of dust and yield antistatic properties (equivalent to a protection film). See [0075-0078]. Aoyama does not disclose a lens surface or sheet. Saitoh teaches a lenticular sheet comprising a UV curable resin on its surface, on the side of a transparent resin film support (of acrylic-col. 6, line 14) that has the lens part on it for liquid crystal displays. The resin film has a protective film on each side of the film and an adhesive agent, adhered to the film (see col. 4, lines 15-55, Figure 12, and col. 5, lines 43-64. At col. 5, lines 47-50, Saitoh explains that both film 7 and protective film 8 are peeled away leaving the adhesive 1110 on the lenticular sheet 1210. Such explanation is equivalent to Applicant's limitation "adhesive being separable together with said protection film from base sheet". It would have been obvious to one of ordinary skill in the art to include a releasable adhesive because Saitoh teaches the advantage of providing a transferable device for lamination purposes at col. 4, lines 25-45. That a transmittance of UV rays transmit through the protection film is a process limitation in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT

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of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. The product of the Applicant and prior art is the same.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,870,224 to Saitoh et al. in view of EP 0924537 to Aoyama et al., as applied to claim 6 above.

Saitoh is relied upon above. Saitoh does not provide for an antistatic agent containing a cationic surface agent. Aoyama teaches an antireflection article for attachment to an optical display such as a liquid crystal display screen. See [0002]-[005]. The substrate (base sheet) is of an acrylic resin (equivalent to a UV-curable resin film layer), see [0043]), as per instant claim 5. A fluoropolymer coating is over the substrate. Antistatic agents and cationic surfactants (equivalent to cationic surface active agent) are employed to the acrylic resin layers and/or the fluoropolymer resin layer to prevent accumulation of dust and yield antistatic properties (equivalent to a protection film). See [0075-0078]. It would have been obvious to one of ordinary skill in the art to include an antistatic and cationic agents because Aoyama provides such an inclusion provides prevention of dust accumulation and yields antistatic properties as cited above. Additionally, it would have been obvious to include a surface resistivity value as claimed to provide electroconductivity as the same materials are employed. Further, Applicant includes the process limitations "the protection film is pasted from the side of the adhesive..." which are not dispositive of the issue of patentability of the present article claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of

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the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same. The surface resistivity and its value given add no positive recitation to the claim as this appears only to occur "after one year". These phrases add nothing to the claim. Therefore, the claim is being interpreted as a protection film.

### *Response to Arguments*

Applicant contests 1110 of Saitoh is equivalent to base sheet 1 of the present invention. Applicant appears to misconstrue the invention of Saitoh. The Examiner does not refer to 1110 as a base sheet. 1110 is the adhesive and 1210 is the base sheet. See col. 5, lines 46-51. Saitoh is therefore still used in the rejection to provide for the essential structure.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 6,166,855 to Ikeyama et al. provides an antireflection film with a cationic surface active agent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tamra L. Dicus  
Examiner  
Art Unit 1774

February 25, 2004

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TECHNICAL STAFF

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